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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,740	04/02/2004	Alfred E. Booth	127982-1000	2811

32914 7590 06/29/2006

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EXAMINER	
HUSON, MONICA ANNE	

ART UNIT	PAPER NUMBER
1732	

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/816,740	BOOTH, ALFRED E.	
	Examiner	Art Unit	
	Monica A. Huson	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *070204*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 29 is objected to because of the following informalities: There are two periods ("..") at the end of the claim. Appropriate correction is required.

Claims 35 and 36 are objected to because of the following informalities: As presently written, these claims are dependent upon claim 36. It is believed that applicant intends them to be dependent upon claim 34. For purposes of examination, they will be treated as dependent upon claim 34. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 12, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 1, 12, and 22, it is unclear how, if the hot pour material is released from the receptacle, the hot pour material is then provided *in* the receptacle (see last stanza of each claim).

Claim 22 recites the limitation "the pour space" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-21 are rejected under 35 USC 103(a) as being unpatentable over Joulia (U.S. Patent 5,861,165), in view of Putzer et al. (U.S. Patent 3,841,822). Regarding Claim 1, Joulia show that it is known to carry out a method for preparing a ready-to-use hot pour material (Abstract) comprising the steps of providing a mold for casting hot pour material in a fluid state, the mold having a top part and a base part and an interior cavity formed thereby with at least one pour space in the top part (Figure 1c, top part=element 1, base part=element 2); applying hot pour material into the mold through the pour space and allowing the hot pour material to cool in the mold (Figure 1c, element A); removing the top part of the mold, wherein the top part is removed upward relative to the base part and hot pour material remains in contact with the base part of the mold (Figure 1e, elements 1, 2, A); placing a first receptacle in direct contact with the hot pour material (Figure 1f, element 4), thereby providing a ready-to-use hot pour material in a first receptacle (Figure 1f, element A, 4). Although Joulia discloses that his receptacle is removable relative to the hot pour material (Column 3, lines 35-40), he does not disclose a method of releasing the hot pour material. Putzer et al., hereafter "Putzer," show that it is known to carry out a method of casting including introducing fluid pressure through the base part of a casting mold to release the hot pour material contacted by a first receptacle (Figure 12, element 29). Putzer and Joulia are combinable because they are concerned with a similar technical field, namely that of methods of casting. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Putzer's release technique during Joulia's molding process to enable formation of hot pour materials that are interchangeable among various receptacles.

Regarding Claim 2, Joulia shows the process as claimed as discussed above in the rejection of claim 1 above, but does not show automation of the process. However, providing an automatic means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art (see MPEP 2144.04 (III)). Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to automate Joulia's process in order to avoid the need for manual checkups and operation of the molding process.

Regarding Claim 3, Joulia shows the process as claimed as discussed above in the rejection of claim 1 above, including a method wherein the top part further comprises a perimeter wall (Figure 1a, element 1), meeting applicant's claim.

Regarding Claim 4, Joulia shows the process as claimed as discussed above in the rejection of claim 1 above, including a method wherein one or more customized portions is at least one recess (Figure 1a, element 1), meeting applicant's claim.

Regarding Claim 5, Joulia shows the process as claimed as discussed above in the rejection of claim 1 above, including a method wherein the base part further comprises a bottom wall (Figure 1e, element 2), meeting applicant's claim.

Regarding Claim 6, Joulia shows the process as claimed as discussed above in the rejection of claim 1 above, including a method wherein one or more customized mold portions is at least one recess (Figure 1e, element 2), meeting applicant's claim.

Regarding Claim 7, Joulia shows the process as claimed as discussed above in the rejection of claim 1 above, including a method wherein the first receptacle is a container (Figure 1f, element 4), meeting applicant's claim.

Regarding Claim 8, Joulia shows the process as claimed as discussed above in the rejection of claim 1 above, but he does not show a pressure fluid

to remove the hot pour material. Putzer shows that it is known to carry out a method wherein the pressure fluid is compressed air (Figure 12, element 29). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Putzer's compressed air release technique during Joulia's molding process to take advantage of effective uses of compressed air.

Regarding Claim 9, Joulia shows the process as claimed as discussed above in the rejection of claim 1 above, including a method further comprising the step of placing the first receptacle in a second receptacle (Column 6, lines 18-20), meeting applicant's claim.

Regarding Claim 10, Joulia shows the process as claimed as discussed above in the rejection of claim 1 above, including a method wherein the surface of the ready-to-use hot pour material extends above the first receptacle side edge (Figure 1f, element 4, A), meeting applicant's claim.

Regarding Claim 11, Joulia shows the process as claimed as discussed above in the rejection of claim 1 above, including a method wherein the mold is in the shape of a uniform design (Figure 1a, element 1, 2), meeting applicant's claim.

Regarding Claim 12, Joulia show that it is known to carry out a method for preparing a customized hot pour material (Abstract) comprising the steps of providing a mold for casting hot pour material in a fluid state, the mold having a top part and a base part and an interior cavity formed thereby, wherein the base part has at least one customized mold portion, and the top part has at least one pour space (Figure 1c, top part=element 1, base part=element 2); applying hot pour material into the mold through the pour space and allowing the hot pour material to cool in the mold (Figure 1c, element A); removing the top part of the mold, wherein the top part is removed upward relative to the base part and hot pour material remains in contact with the base part of the mold (Figure 1e, elements 1, 2, A); placing a first receptacle in direct contact

with the hot pour material (Figure 1f, element 4), thereby providing a ready-to-use hot pour material in a first receptacle (Figure 1f, element A, 4). Although Joulia discloses that his receptacle is removable relative to the hot pour material (Column 3, lines 35-40), he does not disclose a method of releasing the hot pour material. Putzer shows that it is known to carry out a method of casting including introducing fluid pressure through the base part of a casting mold to release the hot pour material contacted by a first receptacle (Figure 12, element 29). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Putzer's release technique during Joulia's molding process to enable formation of hot pour materials that are interchangeable among various receptacles.

Regarding Claim 13, Joulia shows the process as claimed as discussed above in the rejection of claim 12 above, but does not show automation of the process. However, providing an automatic means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art (see MPEP 2144.04 (III)). Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to automate Joulia's process in order to avoid the need for manual checkups and operation of the molding process.

Regarding Claim 14, Joulia shows the process as claimed as discussed above in the rejection of claim 12 above, including a method wherein the top part further comprises a perimeter wall (Figure 1a, element 1), meeting applicant's claim.

Regarding Claim 15, Joulia shows the process as claimed as discussed above in the rejection of claim 14 above, including a method wherein one or more customized portions is at least one recess (Figure 1a, element 1), meeting applicant's claim.

Regarding Claim 16, Joulia shows the process as claimed as discussed above in the rejection of claim 12 above, including a method wherein the base

part further comprises a bottom wall (Figure 1e, element 2), meeting applicant's claim.

Regarding Claim 17, Joulia shows the process as claimed as discussed above in the rejection of claim 12 above, including a method wherein one or more customized mold portions is at least one recess (Figure 1e, element 2), meeting applicant's claim.

Regarding Claim 18, Joulia shows the process as claimed as discussed above in the rejection of claim 12 above, including a method wherein the mold is in the shape of a uniform design (Figure 1a, element 1, 2), meeting applicant's claim.

Regarding Claim 19, Joulia shows the process as claimed as discussed above in the rejection of claim 12 above, including a method wherein the first receptacle is a container (Figure 1f, element 4), meeting applicant's claim.

Regarding Claim 20, Joulia shows the process as claimed as discussed above in the rejection of claim 12 above, including a method further comprising the step of placing the first receptacle in a second receptacle (Column 6, lines 18-20), meeting applicant's claim.

Regarding Claim 21, Joulia shows the process as claimed as discussed above in the rejection of claim 20 above, including a method wherein the surface of the ready-to-use hot pour material extends above the first receptacle side edge (Figure 1f, element 4, A), meeting applicant's claim.

Regarding Claim 22, Joulia show that it is known to carry out a method for preparing a customized hot pour material (Abstract) comprising the steps of providing a mold for casting hot pour material in a fluid state, the mold having a top part and a base part and an interior cavity formed thereby, wherein the base part comprises a bottom wall and has at least one customized mold portion, and the top part customized mold portion (Figure 1c, top part=element 1, base part=element 2); applying hot pour material into the mold through the pour space and allowing the hot pour material to cool in the mold (Figure 1c,

element A); removing the top part of the mold, wherein the top part is removed upward relative to the base part and hot pour material remains in contact with the base part of the mold (Figure 1e, elements 1, 2, A); placing a first receptacle in direct contact with the hot pour material (Figure 1f, element 4), thereby providing a ready-to-use hot pour material in a first receptacle (Figure 1f, element A, 4). Although Joulia discloses that his receptacle is removable relative to the hot pour material (Column 3, lines 35-40), he does not disclose a method of releasing the hot pour material. Putzer shows that it is known to carry out a method of casting including introducing fluid pressure through the base part of a casting mold to release the hot pour material contacted by a first receptacle (Figure 12, element 29). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Putzer's release technique during Joulia's molding process to enable formation of hot pour materials that are interchangeable among various receptacles.

Regarding Claim 23, Joulia shows the process as claimed as discussed above in the rejection of claim 22 above, but does not show automation of the process. However, providing an automatic means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art (see MPEP 2144.04 (III)). Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to automate Joulia's process in order to avoid the need for manual checkups and operation of the molding process.

Regarding Claim 24, Joulia shows the process as claimed as discussed above in the rejection of claim 22 above, including a method wherein one or more customized portions is at least one recess (Figure 1a, element 1), meeting applicant's claim.

Regarding Claim 25, Joulia shows the process as claimed as discussed above in the rejection of claim 22 above, including a method wherein the first receptacle is a container (Figure 1f, element 4), meeting applicant's claim.

Regarding Claim 26, Joulia shows the process as claimed as discussed above in the rejection of claim 22 above, but he does not show a pressure fluid to remove the hot pour material. Putzer shows that it is known to carry out a method wherein the pressure fluid is compressed air which is applied evenly over the customized mold portions (Figure 12, element 29). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Putzer's compressed air release technique during Joulia's molding process to take advantage of effective uses of compressed air.

Regarding Claim 27, Joulia shows the process as claimed as discussed above in the rejection of claim 22 above, including a method wherein the mold is in the shape of a uniform design (Figure 1a, element 1, 2), meeting applicant's claim.

Regarding Claim 28, Joulia shows the process as claimed as discussed above in the rejection of claim 22 above, including a method further comprising the step of placing the first receptacle in a second receptacle (Column 6, lines 18-20), meeting applicant's claim.

Regarding Claim 29, Joulia shows the process as claimed as discussed above in the rejection of claim 22 above, including a method wherein the surface of the ready-to-use hot pour material extends above the first receptacle side edge (Figure 1f, element 4, A), meeting applicant's claim.

Regarding Claim 30, Joulia shows that it is known to have a mold for preparing a customized hot pour cosmetic article (Abstract), the mold capable of receiving a hot pour cosmetic article and comprising a top part with a pour space providing for a predominantly open space at the top (Figure 1a); and a base part with at least one customized mold portion, wherein the customized mold portion is a recess, and wherein the top part and base part are tightly engaged forming an interior cavity therein capable of receiving a hot pour cosmetic article (Figure 1b, 1c, element 1, 2).

Regarding Claim 31, Joulia shows the mold as claimed as discussed above in the rejection of claim 30 above, including a mold wherein the mold is in the shape of a uniform design (Figure 1a, element 1, 2), meeting applicant's claim.

Regarding Claim 32, Joulia shows the mold as claimed as discussed above in the rejection of claim 30 above, including a mold wherein the top part comprises a perimeter wall, a planar surface and a recess (Figure 2b, element 2), but he does not disclose a method of releasing the hot pour material. Putzer shows that it is known to carry out a method of casting including introducing fluid pressure through a mold part of a casting mold (Figure 12, element 29). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Putzer's fluid passage in Joulia's mold to enable easier demolding of the cast article.

Regarding Claim 33, Joulia shows the mold as claimed as discussed above in the rejection of claim 30 above, including a mold wherein the base part further comprises a bottom wall (Figure 1e, element 2), meeting applicant's claim.

Regarding Claim 34, Joulia shows that it is known to have a mold for preparing a customized hot pour cosmetic article (Abstract), the mold capable of receiving a hot pour cosmetic article and comprising a top part with a pour space providing for a predominantly open space at the top (Figure 1a); and a base part with a bottom wall, wherein the customized mold portion is a recess, and wherein the top part and base part are tightly engaged forming an interior cavity therein capable of receiving a hot pour cosmetic article (Figure 1b, 1c, element 1, 2).

Regarding Claim 35 Joulia shows the process as claimed as discussed above in the rejection of claim [34] above, including a method wherein the mold is in the shape of a uniform design (Figure 1a, element 1, 2), meeting applicant's claim.

Regarding Claim 36, Joulia shows the process as claimed as discussed above in the rejection of claim [34] above, including a method wherein one or more customized portions is at least one recess (Figure 1a, element 1), meeting applicant's claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/219425. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are merely broader versions of the '425 claims. Therefore, they are not patentably distinct therefrom, as they are effectively "anticipated" by the

patented claims. Note that the standard is "not patentably distinct" which includes both obviousness and anticipation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Monica A Huson

Monica A Huson

June 26, 2006